

### **REMARKS**

This responds to the Office Action mailed on April 28, 2009.

Claims 2-3, 6, 9, 12-13, 16, 20, and 22-25 are herein amended. Claim 15 is canceled. No claims are added. As a result, claims 2-14 and 16-25 remain pending in this application.

### **Examiner Interview**

The Applicant would like to thank Examiner Jeff Popham for the courtesy of a phone interview conducted on August 14, 2009 between the Examiner and the Applicant's representative, Jim H. Salter. The outstanding Office Action, the pending claims, and the cited references were discussed in the interview. This Amendment and Response is responsive to the Office Action and the matters discussed during the interview.

### **§ 101 Rejection of the Claims**

Claims 2-11, 21, and 22 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action asserted that “[a] storage medium containing content . . . is clearly not a process, machine, a manufacture, or a composition of matter.”<sup>1</sup> Applicants respectfully submit that a storage medium is a manufacture and therefore constitutes statutory subject matter under 35 U.S.C. § 101. Furthermore, independent claim 2 recites, in part, “the storage medium comprising . . . program logic.”<sup>2</sup> According to the MPEP, “When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.”<sup>3</sup> As a result, independent claim 2 and its dependent claims are directed to statutory subject matter under 35 U.S.C. § 101. Thus, Applicants respectfully request withdrawal of the § 101 rejection.

### **§ 112 Rejection of the Claims**

Claims 2-25 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action provided specific examples of language forming the basis of these rejections

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<sup>1</sup> Office Action, page 4.

<sup>2</sup> Claim 2, emphasis added.

<sup>3</sup> MPEP 2106.01(I), fourth paragraph, emphasis added.

only with respect to claims 2-3, 6, 9, 12-13, and 15. Claims 2-3, 6, 9, and 12-13 are herein amended, as well as claims 16, 20, and 22-25. Claim 15 is canceled. Applicants respectfully submit that claims 2-14 and 16-25 are not indefinite under 35 U.S.C. § 112, second paragraph. Thus, Applicants respectfully request withdrawal of the § 112 rejection.

§ 103 Rejection of the Claims

Claims 2-13, 15, 16, and 19-25 were rejected under 35 U.S.C. § 103(a) as being obvious over Benaloh (U.S. 7,065,216) in view of Nonaka (U.S. Publication No. 2002/0035492), Kyle (U.S. 6,141,681), and Morito (U.S. 6,782,190). A determination of obviousness requires a factual showing that “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”<sup>4</sup>

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.<sup>5</sup>

“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.”<sup>6</sup> Applicants respectfully submit that a determination of obviousness is not established for the reason that the scope and content of the cited references, even if combined, do not teach or suggest Applicants’ claimed subject matter or support rational inferences that one of ordinary skill in the art reasonably would be expected to draw to reach Applicants’ claimed subject matter.

Each of independent claims 2, 12, and 16 is herein amended to recite, in part, “program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device.”<sup>7</sup> Subject matter support for these amendments may be found in

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<sup>4</sup> *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

<sup>5</sup> *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007).

<sup>6</sup> *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), *see* MPEP 2145(III), *emphasis added*.

<sup>7</sup> Claims 2, 12, and 16, *emphasis added*.

Applicants' specification, at least at page 10, lines 15-18<sup>8</sup> and lines 24-28,<sup>9</sup> at page 16, lines 15,<sup>10</sup> and in the Abstract.<sup>11</sup> While Benaloh is directed to methods and systems in which "digital content is provided and comprises multiple partition sets, with each partition set comprising a first partition and at least one different version of the first partition,"<sup>12</sup> Benaloh is silent with respect to program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device, as recited in each of claims 2, 12, and 16. Further, as discussed in the above-referenced Examiner Interview, Benaloh stores its decryption code on the playback device, and does not therefore load the program logic with the content as currently claimed. Although Nonaka is directed to a system, apparatus, and method, "for performing rights processing of content data encrypted with content key data based on usage control policy (UCP) data,"<sup>13</sup> nothing in Nonaka discusses or suggests program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device, as recited in each of claims 2, 12, and 16. Despite discussion in Morito of, "DVD disks with unique serial numbers stored in a read only part of the disk for recording data,"<sup>14</sup> Morito fails to disclose or suggest program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device, as recited in each of claims 2, 12, and 16.

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<sup>8</sup> Specification, page 10, lines 15-18, "the content can query the player to determine the configuration of the playback environment and to perform cryptographic operations using the player's keys. Content can thus be designed so that playback will only proceed on players that provide satisfactory responses to queries," emphasis added.

<sup>9</sup> *Id.*, at lines 24-28, "Enabling the content itself to control what data regions are played, makes it possible to embed information in the output by selecting between output data versions with tiny differences. Pirate copies can be traced back to a specific player by analyzing these differences. Because the content contains and enforces its own security policies, . . . ." emphasis added.

<sup>10</sup> *Id.*, at page 16, line 15, "The content can be configured to decide whether it will allow itself to be decoded," emphasis added.

<sup>11</sup> *Id.*, at Abstract, "An exemplary optical disc carries an encrypted digital video title combined with data processing operations that implement the title's security policies and decryption processes. Player devices include a processing environment (e.g., a real-time virtual machine), which plays content by interpreting its processing operations," emphasis added.

<sup>12</sup> Benaloh, col. 1, lines 62-66.

<sup>13</sup> Nonaka, paragraph 0019.

<sup>14</sup> Morito, abstract, internal enumerations omitted.

Kyle discusses “a data package comprising the requested data item and its corresponding executable instructions.”<sup>15</sup> In the same paragraph, Kyle describes “[an] interpreter . . . [that] runs the local executable portion which operates on the local data portion in order to create compatible data which is compatible with [a] local computer application.”<sup>16</sup> Because art must be considered in its entirety,<sup>17</sup> the executable instructions of Kyle “correspond” to the data item of Kyle only in the sense that both are included in the data package of Kyle. This is not functionally equivalent to program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device, as recited in each of claims 2, 12, and 16. Kyle, for example, describes, “Including decryption code as part of the data package ... (e.g., see Kyle col. 5, lines 5-15). Kyle further describes, “a data package [that can] utilize multiple decryption header subsections with a plurality of different decryption instructions corresponding to different encryption methods applied to a single data item and/or the other various header subsections of the data package.” (e.g., see Kyle col. 5, lines 24-32, emphasis added). However, as described in Kyle, the executable instruction portion of the data package only operates on the single data item of the package. Kyle does not describe and cannot support a system that provides program logic corresponding to a portion of the content and loaded on a playback device that can authenticate a revocations list, provide a set of decryption keys for a plurality of versions of the content, and control playback of the entire content. Further, as discussed in the above-referenced Examiner Interview, it would not make sense using Kyle to provide decryption code in each medium and only use the decryption code to decrypt content on that medium. Thus, Kyle is not functionally equivalent to program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device. Nothing in Kyle discusses or suggests program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the

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<sup>15</sup> Kyle, col. 3, lines 64-65, internal references omitted, emphasis added.

<sup>16</sup> *Id.*, col. 4, lines 2-5.

<sup>17</sup> *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), *see* MPEP 2141.02(VI), (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” emphasis added).

same content, the program logic being loaded with the content on the playback device.

Accordingly, the cited references, taken singly or in combination, fail to disclose this element.

For at least these reasons, the scope and content of Benaloh, Nonaka, Kyle, and Morito do not teach or suggest Applicants' claimed subject matter or support rational inferences that one of ordinary skill in the art reasonably would be expected to draw to reach Applicants' claimed subject matter. As a result, a determination of obviousness is not established with respect to any of independent claims 2, 12, and 16, and their respective dependent claims. Thus, Applicants respectfully request withdrawal of the § 103 rejections with respect to claims 2-13, 16, and 19-25.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being obvious over Benaloh in view of Nonaka, Kyle, and Morito, further in view of Sugahra (EP 0 668 695 A2). As discussed above, Benaloh, Nonaka, Kyle, and Morito fail to disclose or suggest program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device. Applicants respectfully submit that claim 14 is not obvious over Benaloh in view of Nonaka, Kyle, and Morito, further in view of Sugahra. Thus, Applicants respectfully request withdrawal of the § 103 rejections with respect to claim 14.

Claim 17 was rejected under 35 U.S.C. § 103(a) as being obvious over Benaloh in view of Nonaka, Kyle, and Morito, further in view of Foote (U.S. 6,164,853). As discussed above, Benaloh, Nonaka, Kyle, and Morito fail to disclose or suggest program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of the same content, the program logic being loaded with the content on the playback device. Applicants respectfully submit that claim 17 is not obvious over Benaloh in view of Nonaka, Kyle, and Morito, further in view of Foote. Thus, Applicants respectfully request withdrawal of the § 103 rejections with respect to claim 17.

Claim 18 was rejected under 35 U.S.C. § 103(a) as being obvious over Benaloh in view of Nonaka, Kyle, and Morito, further in view of Ford (Ford, Susan, "Advanced Encryption Standard (AES) Questions and Answers," 10/2/2000, pp. 1-5). As discussed above, Benaloh, Nonaka, Kyle, and Morito fail to disclose or suggest program logic corresponding to a portion of the content and adapted for execution on a playback device in order to play another portion of

the same content, the program logic being loaded with the content on the playback device.

Applicants respectfully submit that claim 18 is not obvious over Benaloh in view of Nonaka, Kyle, and Morito, further in view of Ford. Thus, Applicants respectfully request withdrawal of the § 103 rejections with respect to claim 18.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402--0938  
(408) 406-4855

Date August 27, 2009

By 

James H. Salter  
Reg. No. 35,668

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 27th day of August, 2009.

Kathryn Grinnell  
Name

  
Signature